

REMARKS / ARGUMENTS

The present application includes pending claims 1-31, all of which have been rejected. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 1-5, 8-15, 18-25, and 28-31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over USPP 2002/0104099 ("Novak") in view of USPP 2002/0054752 ("Wood"). Claims 6, 7, 16, 17, 26, and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Novak and Wood, in view of U.S. Patent No. 7,174,512 ("Martin"). The Applicant respectfully traverses these rejections at least based on the following remarks.

I. Examiner's Response to Arguments

A. Section 5 (pages 3-5 of the Final Office Action)

The Examiner states the following in page 5 of the "Response to Arguments" section of the Final Office Action:

Regarding the "organizing ... at least a portion of television broadcast media..." limitation of Claim 1, the Examiner submits that Applicant has not provided sufficient evidence to support the argument that the organization of "television broadcast media" (in a "mass-communicated" broadcast sense) can be performed at the first geographic location (as originally presented in Office Action Page 7). Both the Applicant and the Examiner have identified Paragraph [47] of the instant application as evidence of support of "organizing ... television broadcast media". However ... the Examiner emphasizes that this passage is directed toward

the presentation of media at Applicant's claimed "second location" and not the "first location". Furthermore, it is the Examiner's position that Paragraph [47] of the instant application demonstrates that a "broadcast television station" and/or a "cable provider" organizes and distributes the "broadcast media".

The Applicant respectfully disagrees with the above argument and points out that the claims are fully supported by the present specification. With regard to the "organizing ... at least a portion of television broadcast media..." limitation of Claim 1, the Examiner is referred to, for example, Fig. 2 and paragraph 37 of the specification, which disclose that the media exchange software platform of the personal computer environment (e.g., 101, 107, or 109 in Fig. 1) may "store a mixture of commercial broadcast programs and personal media programs into channels of the media guide interface." in addition, "data representative of local media, personal media and/or commercial broadcast programs may be presented in the channel guide 212, media guide 214, and/or device guide 213." **Therefore, neither the location of the server 124 nor the location of the local studio 106 (or even the location of the uploader 122) is used for purposes of organizing the synthetic channel to include the transferred personal media and broadcast programming. In this regard, Novak does not disclose or suggest at least the limitation of "organizing, at said first geographic location, said located media and at least a portion of television broadcast media into channels," as recited by the Applicant in independent claim 1.**

B. Section 6 (page 6 of the Final Office Action)

With regard to the “transparently transferring” limitation, the Examiner states the following in page 6 of the Final Office Action:

Applicant also presents that Novak does not teach “transparently transferring from said first location, at least a portion of said organized channels to at least a second location within the communication network” because “at step 406, a token or electronic file is sent to the end user to subscribe the end user's terminal (set top box 152) to the synthetic channel”. Applicant cites Novak Paragraph [0058] “discloses that the individual (who uploads the media to server or web site 124) emails the token or other electronic file to the end user” and states that “Obviously, the user will be aware of such emailed token” (Reply Pages 19-20). The Examiner respectfully disagrees.

The Examiner first notes the Applicant has not provided evidence to support a statement of obviousness regarding the user being aware of an emailed token.

...

Additionally, the Examiner has also cited Novak's teachings of a Java applet that is automatically downloaded and triggers an update of EPG 153 (as described in Paragraph [0080]) to address the claimed “transparently transferring” limitation.

The Applicant respectfully disagrees, especially with the above emphasized portions of the argument. The Examiner alleges that the Applicant “has not provided evidence to support a statement of obviousness regarding the user being aware of an emailed token.” In response, the Examiner is referred to paragraph 0080 of Novak, where it is disclosed that the token is emailed to the end user as an attachment. Obviously, an email attachment cannot open/launch by itself, and it has to be opened/launched by the

email recipient. Paragraph 0080 further states that the subscription token updates the EPG when the token attachment is installed or launched. Therefore, the user has to be aware of the emailed token since the token is emailed as an attachment, which has to be opened by the user in order to be installed.

The Examiner also cites Novak's teaching of a Java applet and alleged automatic download of the applet. Even though Novak discloses that a Java applet or Javascript is automatically downloaded, the Examiner has not mentioned how that automatic download takes place. More specifically, the end user has to navigate to the web site 124, and upon reaching the web site 124, the automatic applet download takes place. In this regard, similarly to the previous example of the token emailed as attachment, in this instance a specific action by the end user is also required so that the applet download can take place. Therefore, the Applicant maintains that in both of the above examples given by the Examiner, there is no transparent transferring, as alleged by the Examiner.

REJECTION UNDER 35 U.S.C. § 103

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure, Rev. 6, Sep. 2007 ("MPEP") states the following:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

See the MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), and *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval). Further, MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" (citing *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007)). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

II. The Proposed Combination of Novak and Wood Does Not Render Claims 1-5, 8-15, 18-25, and 28-31 Unpatentable

The Applicant now turns to the rejection of claims 1-5, 8-15, 18-25, and 28-31 as being unpatentable over Novak in view of Wood. The Applicant notes that the proposed combination of Novak and Wood forms the basis for all of the pending rejections.

A. Rejection of Independent Claim 1

With regard to the rejection of independent claim 1 under 103(a), the Applicant submits that the combination of Novak and Wood does not disclose or suggest at least the limitation of “transparently transferring from said first geographic location, at least a portion of said organized channels to at least a second geographic location within the communication network,” as recited by the Applicant in independent claim 1.

The Final Office Action states:

The claimed "transparently transferring from said first geographic location, at least a portion of said organized channels to at least a second geographic location within the communication network" is met by the Novak reference that teaches client terminal of end user at STB 152 receiving media files associated with the 'synthetic' channel when it is selected for viewing- whereby a 'synthetic' channel is added to an user's EPG 153 at a 2nd location, via an emailed token or other electronic file, such as a Java applet that is automatically downloaded and triggers an update of EPG 153 (Figs. 1,2,4,9, 11; paragraphs 0041,0058, 0059, 0080, 0085, & 0086).

See the Final Office Action at pages 7-8. The Applicant respectfully disagrees with the above argument, especially the above bolded portion. Referring to FIG. 4 of

Novak, the Applicant points out that at step 406, a token or electronic file is **sent to the end user** to subscribe the end user's terminal (set top box 152) to the synthetic channel. More specifically, Novak, at ¶ 0058, discloses that the individual (who uploads the media to server or web site 124) **emails the token or other electronic file to the end user. Obviously, the user will be aware of such emailed token.**

Novak, at paragraph 0080, discloses that the token is emailed to the end user as an attachment. **Obviously, an email attachment cannot open/launch by itself, and it has to be opened/launched by the email recipient.** Paragraph 0080 further states that the subscription token updates the EPG when the token attachment is installed or launched. Therefore, **the user has to be aware of the emailed token since the token is emailed as an attachment, which has to be opened by the user in order to be installed.**

In addition, even though Novak at paragraph 0080 discloses that a Java applet or Javascript is automatically downloaded, the end user still has to navigate to the web site 124, and upon reaching the web site 124, the automatic applet download takes place. In this regard, similarly to the previous example of the token emailed as attachment, in this instance a specific action by the end user is also required so that the applet download can take place. Therefore, **the Applicant maintains that in both of the above examples given by the Examiner, there is no transparent transferring, as alleged by the Examiner.**

In this regard, Novak also does not disclose that at least a portion of the channel itself is transparently transferred to at least a second location within the communication network, as recited in Applicant's claim 1. Furthermore, the Applicant submits that the fact that a token or an electronic file is transferred to effectuate subscription to the synthetic channel illustrates that the transfer of information is not transparent.

Wood does not overcome the above deficiencies of Novak.

Accordingly, independent claim 1 is not unpatentable over the combination of Novak and Wood, and is allowable. Independent claims 11 and 21 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 11 and 21 are also allowable over the reference cited in the Office Action at least for the reasons stated above with regard to claim 1.

B. Rejection of Dependent Claims 2-5, 8-10, 12-15, 18-20, 22-25, and 28-31

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11, and 21 under 35 U.S.C. § 102(e) as being anticipated by Novak has been overcome and requests that the rejection be withdrawn. Additionally, claims 2-5, 8-10, 12-15, 18-20, 22-25, and 28-31 depend from independent claims 1, 11, and 21, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 2-5, 8-10, 12-15, 18-20, 22-25, and 28-31.

III. The Proposed Combination of Novak, Wood and Martin Does Not Render Claims 6, 7, 16, 17, 26, and 27 Unpatentable

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11, and 21 under 35 U.S.C. § 102(e) as being anticipated by Novak has been overcome and requests that the rejection be withdrawn. Additionally, since the additional cited reference (Martin) does not overcome the deficiencies of Novak, claims 6, 7, 16, 17, 26, and 27 depend from independent claims 1, 11, and 21, respectively, and are, consequently, also respectfully submitted to be allowable at least for the reasons stated above with regard to allowability of claim 1. The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 6, 7, 16, 17, 26, and 27.

In general, the Final Office Action makes various statements regarding claims 1-31 and the cited reference that are now moot in light of the above. Thus, the Applicant will not address such statements at the present time. However, the Applicant expressly reserves the right to challenge such statements in the future should the need arise (e.g.,

Application № 10/675,287
Reply to Final Office Action of 05/05/2009

if such statement should become relevant by appearing in a rejection of any current or future claim).

CONCLUSION

Based on at least the foregoing, the Applicant believes that all claims 1-31 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

Date: July 6, 2009

/Ognyan I. Beremski/

Ognyan Beremski, Esq.
Registration No. 51,458
Attorney for Applicant

MCANDREWS, HELD & MALLOY, LTD.
500 WEST MADISON STREET, 34TH FLOOR
CHICAGO, ILLINOIS 60661
(312) 775-8000

/OIB